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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,319	09/29/2003	Nicholas M. Middleton	03-12585	5280

25189 7590 03/09/2004  
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SANTA MONICA, CA 90401-1211

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/675,319	<b>Applicant(s)</b> MIDDLETON, NICHOLAS M.	
	<b>Examiner</b> Sebastiano Passaniti	<b>Art Unit</b> 3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/29/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office action is responsive to communication received 09/29/2003 – application papers filed.

This application is a CON of 10/112,207, filed 03/28/2002, now U.S. Patent No. 6,634,955, which is a CIP of 09/971,319, filed 10/03/2001, now U.S. Patent No. 6,435,975, which is a CON of 09/491,570, filed 01/26/2000, now abandoned.

Claims 1-6 are pending.

Following is an action on the MERITS:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, the preamble recites that the attachment is “for a putter head”, yet the body of the claim calls for a recess being defined behind, in front of, or above the putter head. It is unclear if the applicant intends to claim the combination of a putter head and the attachment or simply the attachment. Clarification is requested. In addition, the term “conventional” used throughout the claims and notably in claim 1, line 6, is indefinite as the scope of the claim with this term cannot be accurately determined. What may be considered as conventional by today’s definition(s) may not necessarily be what is considered conventional tomorrow or in the future. Thus, the meaning of conventional as it applies to the size or shape or other characteristic of the claimed golf

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ball is not readily understood. Moreover, the applicant has not provided a definition of this term within the specification as a guide for the skilled artisan to understand exactly how this term is to be interpreted. In line 8, "said ball" implies that the ball is to be positively recited. Similarly, the language "Said faces or edges" implies that these features are to be positively recited. Clarification is requested. Note, the language "the said" in lines 7 and 8 may simply read - -the- - or - -said- -. Last, the language "such as" in line 6 renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

As to claim 2, it is unclear how a plurality of recesses may be defined, when the attachment has been defined as sized to receive an object such as a golf ball. Here again, note the use of the term "conventional".

As to claim 3, line 3, "conventionally" is indefinite. See the comments for claim 1, *supra*.

As to claim 4, line 2, what is an arcuate hoop. This language would appear to be redundant. Does not a hoop by definition include part of an arcuate shape? In line 4, "conventional" is indefinite as described in the explanation for claim 1, *supra*.

As to claim 5, line 3, the "striking face" appears to be positively recited (unlike claim 3 wherein the striking face is part of a functional phrase, ... "adapted to be disposed behind the striking face..."). If the striking face is to be a positive structural feature within the body of the claim, then proper antecedent basis must be provided. In line 5, "conventional" is indefinite for the reasons advanced above under claim 1.

As to claim 6, no "means for attachment" can ensure total and complete uniformity and repeatability of attachment. Thus, the claim language is indefinite and inaccurate. Perhaps "ensures" should instead read --provides--.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Shier. This rejection of claims 1, 5 and 6 takes into account the interpretation of these claims in a way that includes the positive recitation of the combination of a putter head and an associated attachment. As to claim 1, the attachment in Shier is adapted to be attached to a putter head in front of the striking face and is adapted to receive a golf ball between the parallel planar faces of the guiding portions (74, 76). Thus, the movement of a golf ball placed in contact with the ball striking face of the putter head may be restricted. As to claim 5, the "limbs" include the guiding members (74, 76) which are shown to extend generally perpendicular to the plane of the striking face. The distance between the guide members may accommodate a golf ball (Figure 4). As to claim 6, the strap and VELCRO (hook and loop) arrangement shown in Figures 1 and 2 enable the attachment to be repeatedly installed on and removed from the putter head body.

Claims 1, 3, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Brzezinski. The gauge disclosed by Brzezinski includes features such as the rods (12, 14) that may serve as the claimed attachment means and may be adapted to be

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connected to a golf putter either at the face or at the rear of a putter head. For instance, the putter head may include apertures for receiving the rods (12, 14). Further, the Brzezinski device defines a hoop structure, as required by claim 4, and may clearly be repeatedly attached to and removed from a putter head, as required in claim 6. It is noted that the language "adapted to" or "capable of being attached" used throughout the claims is merely functional in nature and does not add any further structure to the claims. Thus, the claimed structure is deemed to be anticipated by Brzezinski.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Fatur. The attachment in Fatur includes multiple recesses or apertures (40). In addition, at least one recess defined by the generally u-shape opening may loosely receive a golf ball therein. The plural recesses (40) are capable of being sized to receive a golf ball. It is noted that the language "may be sized" used in the claim is merely functional in nature and does not add any further structure to the claims. Thus, the claimed structure is deemed to be anticipated by Fatur.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show a plurality of recesses, as detailed in claim 2, as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

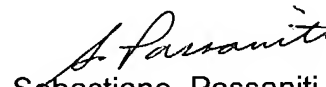
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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Figure 1 in Case. Note Figures 1 and 3 in Eckert. Matyas and McClosky show designs of interest. Observe Figure 4 in Polsky.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
March 4, 2004